



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,407	07/06/2000	Junichi Umehara	9366/203	7124

757 7590 01/20/2004

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60611

EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,407

Applicant(s)

UMEHARA, JUNICHI

Examiner

Yogesh C Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 14, 16, 17, 20-24, 27-32, 35-38, 41, 49-52, 54-57, 60, 62, 63 and 67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-11, 14, 16-17, 20-24, 27-32, 35-38, 41, 49-52, 54-57, 60, 62-63 & 67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Response to Amendment***

1. Amendment B, paper # 11, received on October 20, 2003, is acknowledged and entered. Claims 12, 13, 15, 18-19, 25, 26, 33-34, 39-40, 42-45, 47-48, 53, 58-59, 61, and 64-66 are cancelled. Claims 1, 20, 23-24, 30, 46, 50, and 54 have been amended. Currently claims 1-11, 14, 16-7, 20-24, 27-32, 35-38, 41, 49-52, 54-57, 60, 62-63 and 67 are pending for examination.

Response to Arguments

2.1. Regarding rejection of claims 1-5, 7-9, 14, 16-17, 20-21, 23-26, 28-29, 30-31, 33-35, 41, 46-56, 60, and 62-63, the applicant argues that reference Harvey does not teach transmitting the image file directly to the user's printer from the provider (see amendment B, page 15). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Claims 1-5, 7-9, 14, 16-17, 20-21, 23-26, 28-29, 30-31, 33-35, 41, 46-56, 60, and 62-63 were rejected under 35 U.S. C. 103 (a) as unpatentable over Ryan in view of Harvey. (Ryan teaches transmitting image file to the user's printer from the provider as detailed in the earlier office action on pages 7- 8.

The applicant further argues that Ryan and Harvey, either singly or in combination does not teach that a request for printing is submitted by a consumer's

Art Unit: 3625

computer and that the printing is controlled by the provider's computer (see amendment B, page 15). The examiner respectfully disagrees. Ryan does teach that a request for printing is submitted by a consumer's computer and that the printing is controlled by the provider's computer (see at least FIG.1, where the user I/F-38 requests the data center server 24 via a network desired indicia for printing, also see FIG.2, where user-100 requests the data center server -120 via network for the desired indicia and col.4, lines 6-37. Note: The requested indicia is transmitted by the data center computer via a network to the consumer's printer and that indicia and this corresponds to the fact the printing of indicia on the consumer's printer is controlled by the provider's computer. As analyzed in the earlier office action, the Data center 20 in Ryan corresponds to the provider's computer.

The applicant also argues that the printing control helps to reduce the possibility for altering or forging the electronic certificate ((see amendment B, page 15). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., printing control helps to reduce the possibility for altering or forging the electronic certificate) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, the examiner would like to state that it was well-known at the time of the applicant's invention to convert data via a printer driver to one or more image representations before transmitting them to a designated address via network to prevent recipients from altering the received data in image format (For mere evidence refer to Kelly, US Patent 6, 442, 595, and see at least col.4, lines 35-49, col.8, lines 32-38, and col.9, line 35-col.10, line 30).

Art Unit: 3625

In view of the foregoing, the rejection of amended claims 1-5, 7-9, 14, 16-17, 20-21, 23-26, 28-29, 30-31, 33-35, 41, 46, 49-52, 54-56, 60, and 62-63 is maintained under 35 U.S.C. 103(a) as being unpatentable over Ryan and further in view of Harvey.

2.2 The arguments filed concerning newly amended claims 6, 10, 11, 22, 27, 38, and 57 (Note: claims 12-13, 15, 18-19, 39-40, 42-45, 58-59, 61, and 64-65 are cancelled) have been considered but are moot in view of the new ground(s) of rejection.

2.3 Applicant's arguments with respect to newly amended claims 32, 36-37, and 67 have been considered but are moot in view of the new ground(s) of rejection.

2.4 This action is final.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.1. Claims 1-5, 7-9, 14, 16-17, 20-21, 23-26, 28-29, 30-32, 41, 46, 49-52, 54-56, 60, and 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan and further in view of Harvey.

Art Unit: 3625

Regarding claims 1-5, 20-21, 23-26, 30-32, 46, 49-52, and 54-56, Ryan teaches a method, a system and a printing device for conducting electronic transactions comprising: establishing a first communication connection to a provider from a consumer computer, and said communication connection is via Internet or optical communication or wire less medium, submitting a request for transaction with consumer's identification and printer identification information, provider processing said transaction and generating electronic certificated data, establishing a second communication by provider to a consumer printer to transmit said authorized electronic certificate data and printing instructions to the consumer's printer without involvement of a consumer or a consumer's computer, provider controlling the printing of an electronic certificate on the consumer's printer, acknowledging receipt of said printing data directly to said remote provider, and consumer's printer can use two or more communication connections directly with the provider(see at least col.3, line 36-col.5, line 36 & Figs.1-2. Note: Data center 20 corresponds to the provider in the application. Indicia data corresponds to electronic certificate data and the printer module at the consumer's end prints it. The printing of electronic certificate data at the consumer's printer is controlled by the Data center without involvement from consumer or consumer's computer the data center verifies that the printer module is authorized to print that authorized document data [at least see col.3, lines 40-45]. At step 135, Fig.2, printer acknowledges receipt of the printing data from the provider directly. Col.4, lines 58-60 teach communication connection is via Internet or optical communication or wireless medium. While communicating on Internet via browser like Netscape or Internet explorer the printers can have two or communication connections directly with the provider. It is also inherent that printers would function in response to drivers either on the resident driver or to a remote driver.).

Ryan does not teach that the printing data such as electronic certificate/document contains an image file. However, in the same field of postage indicia printing and from the same assignee, Pitney Bowes Inc., Harvey teaches that the printing data such as electronic certificate/document contains an image file (see at least col.2, line 29-col.3, 53, "... *The present invention.....print processing application or print image manipulation application.....The application supplies a modified print file containing the final print images for the documents*", col.5, lines 13-17, "... *The applications 19 facilitate batch processing to produce print files 21, containing large numbers of document images.....*", col.12, lines 20-34, col.14, lines 6-34, col.19, lines 5-16,). In view of Harvey, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Ryan to include the feature that the printing data such as electronic certificate/document contains an image file because when the printing data is in the form of image it helps to merge a number of images or modify them such as merging the image of an address or modifying the print image of a document as explicitly disclosed in Harvey (see at least col.2, lines 46-55).

Regarding claims 7-9, 28-29, Ryan/Harvey further teaches providing an identification indicia for printing on said electronic certificate, transmitting it to the consumer's printer with the image file and printing the identification indicia on said electronic certificate, confirming that said indicia was printed on said electronic certificate and maintaining print-confirmation for said electronic certificate by said provider (at least see Ryan, col.3, lines 49-col.4, lines 24, col.5, lines 9-29, and col.5, line 58-col.6, line 8). Ryan/Harvey also discloses printing authentic certificates of different dimensions (at least see Ryan, col.4, lines 30-32. Envelope and metering tape correspond to certificates of different dimensions).

Regarding claims 14, and 60, Ryan/Harvey teaches printing original postage label and an associated pick-up schedule label (at least see Ryan, col.4, lines 26-50, "*..print directly on envelopes or meter tape.....label printer*". Note: label printer can print postage label as well pick-up schedule label).

Regarding claims 16-17, 41 and 62-63, Ryan/Harvey discloses requesting the user to make payment and print original receipt (at least see Ryan, col.5, lines 46-57).

Regarding claim 32, Ryan/Harvey as applied to claim 30 teaches a printing device, for conducting electronic transactions, transmitting a selected indicia on a remote printer and printing it as disclosed and analyzed above. Ryan/Harvey as applied to claim 30 does not disclose means for canceling a printed image material and for sending information about cancellation of said image material to said remote printer. However, Harvey teaches means for canceling a printed image material and for sending information about cancellation of said image material to said remote printer (see at least col.18, lines 32-37. Here, Harvey discloses that if a error is detected in the printed image of the address the same can be cancelled and corrected on the remote printer of the consumer but controlled by the provider's computer. The very fact that after the address is cancelled and then corrected and after words no further action is taken by the provider's controller the information of canceling the wrong address and then modifying it to the correct address is sent to the provider's computer.). In view of Harvey, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified Ryan/Harvey as applied to claim 30 to incorporate the means for canceling a printed image material and for sending information about cancellation of said

Art Unit: 3625

image material to said remote printer because it will allow the system to cancel and correct the printed image of a wrong or undesirable data.

3.2. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan and in view of Harvey and further in view of the admitted prior art by the applicant.

Regarding claim 35, Ryan in view of Harvey as applied to claim 30 discloses a printing device associated with a consumer and analyzed above. Ryan in view of Harvey as applied to claim 30 does not disclose means for printing an authentic label for a CD ROM. However, the applicant has admitted printing on CD ROM as a prior art (see disclosure, page 9, line 21-page 10, line 5. Note: The applicant's attention is invited to the examiner's argument submitted in the earlier office action on page 2 that the applicant admits printing on CD-ROM as a prior art. The applicant has not traversed this argument of the examiner and as such it is implied that the applicant agrees to the examiner's view that printing on CD ROM is an admitted prior art.). In view of the fact that printing on CD ROM is an admitted prior art it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified Ryan in view of Harvey as applied to claim 30 to incorporate the feature of printing authentic labels on CD Rom because the labels inform the users the contents downloaded on CD ROM.

4. Claims 6, 22, 27, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan/Harvey and further in view of Hayward et al. (US 2003/0023703 A1), hereinafter, referred to as Hayward.

With regards to claims 6, 22, and 27, Ryan/Harvey teaches a method and system for conducting electronic transactions as disclosed in claim 1, 20 and 23 and analyzed above. Ryan/Harvey does not teach that said provider confirming that said printer has sufficient supplies and is connected to the network and replenishing said printer with supplies. However, in the field of same endeavor, Hayward teaches that a provider confirming that said printer has sufficient supplies and is connected to the network and replenishing said printer with supplies (see at least page 3, paragraphs 0033-0044). Doing so would ensure to provide enhanced user support information online for computer peripherals like printers, fax machines, etc. by eliminating the need for the user to first know what replacements are needed and then seek the source for their replacements and finally order and buy those replacements so as not to delay or stop the work. .

5. Claims 10, 38, and 57 are rejected under 35 U.S.C. 103(a) as being obvious over Ryan/Harvey and further in view of Official Notice

5.1. With regards to claim 10, Ryan/Harvey teaches a method for conducting electronic transactions as disclosed in claim 1, and analyzed above. Ryan/Harvey does not teach using bar code for identification indicia. Official Notice is taken of the notoriously known concept and benefits of printing bar codes to represent binary information for numbers, letters, or a combination of two, on books, grocery, items, merchandise, etc., that can be read by an optical spanner. Doing so ensures a rapid and error-free input to identify an item, as described above.

5.2. With regards to claims 38, and 57, Ryan/Harvey teaches a method and a printing device, for conducting electronic transactions, transmitting a selected indicia on a remote printer and printing it as disclosed in claims, 30, and 54 and analyzed above. Ryan/Harvey does not disclose printing original financial certificates, tickets, stamps, original credit, debit and pre-pay cards with suitable available printers. Note: disclosure admits using suitable printers to print these items (page 6, lines 6-10 and page 10, lines 6-11) and does not teach the special means required for each time of item listed above. It is, therefore, understood that applicant admits that suitable printers are a prior art available at the time of the invention to print these items if data is downloaded to these printers from a remote source. Ryan/Harvey also discloses transmitting data from a remote source to a printer to print the desired indicia on any medium. Official Notice is taken of the concept and benefits of printing original financial certificates, tickets, stamps, original credit, debit and pre-pay cards with suitable available printers. Doing so would ensure a rapid, economical and error-free transaction of printing original financial certificates, tickets, stamps, original credit, debit and pre-pay cards with suitable available printers.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan/Harvey and further in view of Grapes (US Patent 6,446,130).

With regards to claim 11, Ryan/Harvey teaches a method for conducting electronic transactions as disclosed in claim 1, and analyzed above. Ryan/Harvey does not teach cutting around said printing of said electronic certificate. However, Grapes, in the field of same endeavor, teaches cutting around said printing of said electronic certificate (see at least col.8, lines 4-12). In view, of Grapes, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified

Ryan in view of Harvey to incorporate the feature of using cutter to cut around electronic certificates because these features are important as they allow the system to operate without a human supervising and the printed material can be presented as a finished material as explicitly disclosed in Grapes.

7. Claims 36-37 are, rejected under 35 U.S.C. 103(a) as being obvious over Ryan/Harvey and in view of Templeton (US Patent 6,547,132) and further Official Notice.

Regarding claim 36, Ryan/Harvey/Golden teaches a printing device, for conducting electronic transactions, transmitting a selected indicia on a remote printer and printing it, canceling the printing material as disclosed in claim 32 and analyzed above. Ryan/Harvey does not disclose means for defacing said printed material. However, Templeton teaches defacing of printed objects like checks (see at least col.7, lines 36-48, “ *Merchant re-inserts check to void/deface...*”). Note: The check corresponds to the printed material like a ticket, or document or certificate). In view of Templeton, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified Ryan in view of Harvey to incorporate the feature of defacing said printed material because it will allow the system to stop the consumers from using cancelled documents/tickets/etc..

As regards means for scanning an image of said printed material in defaced form to said remote provider, the examiner takes official notice. It is notoriously well-known at the time of the applicant's invention to use scanners to convert documents, images, drawings into digitized form so that the data on documents/images/drawings can be transmitted electronically. In view of Official Notice, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified Ryan in view of Harvey and in view of Templeton as applied to claim 36 above to incorporate the

means for scanning an image of said printed material in defaced form to said remote provider because the receipt of the image of the defaced printed material will ensure to the provider that the user has in fact cancelled the document/ticket and cannot use it.

As regards the limitation of means for sending an image of said printed material in defaced form to said remote provider, it is already covered in claims 30 and 32 above that Ryan/Harvey teaches transmission of documents/information electronically.

Regarding claim 37, the limitation, " means for reading identification code by a magnetic bar code reader is already covered and analyzed in claim 10 and is therefore rejected as being obvious over Ryan/Harvey in view of Official Notice. Note: This rejection for claim 10 was also submitted in earlier office action to which the applicant has not argued implying that the applicant accepts uses of bar-codes and means for reading bar-codes are accepted prior art.

Further, the limitation, " means for sending identification read from said printed material to said remote provider "is already covered in claims 30 and 32 above that Ryan/Harvey teaches transmission of documents/information electronically.

8. Claim 67 is, rejected under 35 U.S.C. 103(a) as being obvious over Ryan/Harvey and in view of Official Notice and further in view of Hayward et al. (US 2003/0023703 A1), hereinafter, referred to as Hayward.

Regarding claim 67, Ryan/Harvey teaches a method, for printing original documents on a remote printer, as disclosed in claim 54 and analyzed above. Ryan/Harvey does not disclose use of an intermediary while transmitting first and second electronic certificate data to a remote printer and that intermediary provides

maintenance for the printers. Official Notice is taken of the knowledge generally available about the concept and benefits of using intermediaries both in conventional business (without online) and online business are well known. Use of intermediaries in online business is expected to include online transmitting, downloading and printing of first and second electronic certificate data on a remote printer. By doing so, it will help to more efficient fulfillment of orders online and reduce administrative and home delivery costs of replenishing parts and supplies to the printer and improve the availability.

As regards the intended function of the intermediary to check consumer print supplies, it is already covered in claims 6,22, and 27 above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,442,595 B1 to Kelly discloses automated electronic document transmission per request of a consumer in an image format such that the consumer cannot alter or forge the documents on receipt (see at least col.4, lines 35-49, col.8, lines 32-38, and col.9, line 35-col.10, line 30).

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

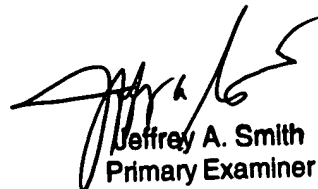
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin can be reached on 703-308- 1065. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg
Examiner
Art Unit 3625

YCG
January 10, 2004



Jeffrey A. Smith
Primary Examiner